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In re Application of :
Uwe Wenzel et al :
Serial No.: 09/782,306 : PETITION DECISION
Filed: February 14, 2001 :
Attorney Docket No.: PF 51202 :

This is in response to the petition under 37 CFR 1.181, filed December 20, 2006, requesting withdrawal of the Finality of the last Office action.

BACKGROUND *

A review of the relevant file history shows that following the filing of RCE papers on August 6, 2004, the examiner mailed a first non-Final Office action to applicants on December 28, 2004, a second non-Final Office action on August 11, 2005, and a third non-Final Office action on April 10, 2006. The last Office action contained a rejection of claims 1-1 and 13 under 35 U.S.C. 102(b) as anticipated by Koda or Gionfriddo, both in Abstract form.

Applicants replied to the last non-Final Office action on July 10, 2006, by canceling claims 2 and 13 and amending claim 1 to eliminate the sugar value for R⁷ and limit several other variables. Applicants argued the claim now defined over the applied prior art.

The examiner mailed a new Office action to applicants on September 22, 2006, rejecting claim 1 (the only remaining claim) under 35 U.S.C. 102(b) as anticipated by Watanabe et al (US 5650433). The examiner made the action Final based on applicants' amendments necessitating the application of a new reference.

This petition was filed December 20, 2006, to withdraw the finality of the Office action. A reply to the Office action was filed concurrently, and the examiner mailed an Advisory Action to applicants on January 16, 2007, indicating the arguments did not place the application in condition for allowance.

Applicants filed a Notice of Appeal on January 26, 2006.

DISCUSSION

Applicants state that the examiner's application of a new reference in the Office action mailed September 22, 2006, and making of the action Final was improper as applicants' amendments did not cause the need for application of a new reference and rejection.

All of the compounds claimed belong to the general class of flavones. A review of the claims before the amendment of July 10, 2006, and afterwards shows that claim 1 contained variable R⁷ defined as being hydrogen, hydroxy or methoxy (the same as R⁵, R⁶ and R⁸) and also as being a sugar substituents, but afterward was limited to hydrogen alone. The examiner's applied art prior to the narrowing of the claims by amendment appears to have focused on flavones having a sugar substituent at the R⁷ position and not on the breadth of the claims as encompassing all types of flavones. It could reasonably have been predicted that applicants would amend their claims in response to the references applied so as to avoid the compounds claimed therein, based on the known general class of flavones. Thus, the application of a different reference (Watanabe et al) that was already of record was not necessitated by applicants' amendment. It is also noted that Watanabe et al was cited, but not applied, in the first Office on the merits, mailed February 13, 2003. It is further noted that the Office actions mailed December 28, 2004, and August 11, 2005, stated that the (broader) claims of record avoided the prior art of record (including Watanabe et al). The examiner's failure to timely apply Watanabe et al should not inure to applicants' detriment by having it applied now and the action made Final.

DECISION

The petition is **GRANTED**. The Office action mailed September 22, 2006, is designated as a non-Final Office action. The response filed December 20, 2006, will be considered a reply to a non-Final Office action and will be entered.

The Notice of Appeal is considered premature in view of the above decision and is withdrawn inasmuch as the application has not been twice rejected for the same reasons. The application will be forwarded to the examiner for further consideration of the amendment filed December 20, 2006, and further action not inconsistent therewith.

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number 571-273-8300.



George C. Elliott
Director, Technology Center 1600